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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,065	10/19/2000	John F. Acres	4164-158	8782
7590 03/17/2004			EXAMINER	
Alan T. McCollom			COBURN, CORBETT B	
MARGER JOHNSON & McCOLLOM, P.C 1030 S.W. Morrison Street			ART UNIT	PAPER NUMBER
Portland, OR 97205			3714	
			DATE MAILED: 03/17/2004	18

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	09/694,065	ACRES, JOHN F.
Notice of Abandonment	Examiner	Art Unit
	Corbett B. Coburn	3714
The MAILING DATE of this communication app	<u> </u>	
This application is abandoned in view of:	,	
<ol> <li>Applicant's failure to timely file a proper reply to the Office         <ul> <li>(a)  A reply was received on (with a Certificate of N period for reply (including a total extension of time of</li> </ul> </li> </ol>	failing or Transmission dated month(s)) which expired on	
(b) A proposed reply was received on, but it does	•	
(A proper reply under 37 CFR 1.113 to a final rejection application in condition for allowance; (2) a timely filed Continued Examination (RCE) in compliance with 37 (	Notice of Appeal (with appeal fee);	
(c) ☐ A reply was received on but it does not constitution final rejection. See 37 CFR 1.85(a) and 1.111. (See		mpt at a proper reply, to the non-
(d) ☐ No reply has been received.		
2. Applicant's failure to timely pay the required issue fee and from the mailing date of the Notice of Allowance (PTOL-8	35).	- 1
(a) ☐ The issue fee and publication fee, if applicable, was), which is after the expiration of the statutory position. Allowance (PTOL-85).	s received on (with a Certificate in a certificate	ate of Mailing or Transmission dated nd publication fee) set in the Notice of
(b) The submitted fee of \$ is insufficient. A balance		
The issue fee required by 37 CFR 1.18 is \$	The publication fee, if required by 37	CFR 1.18(d), is \$
(c) ☐ The issue fee and publication fee, if applicable, has no	ot been received.	
3. Applicant's failure to timely file corrected drawings as requ Allowability (PTO-37).		
(a) ☐ Proposed corrected drawings were received on after the expiration of the period for reply.	_ (with a Certificate of Mailing or Trar	nsmission dated), which is
(b) ☐ No corrected drawings have been received.		
4. The letter of express abandonment which is signed by the the applicants.	e attorney or agent of record, the ass	ignee of the entire interest, or all of
5. The letter of express abandonment which is signed by an 1.34(a)) upon the filing of a continuing application.	n attorney or agent (acting in a repres	entative capacity under 37 CFR
6. The decision by the Board of Patent Appeals and Interfer of the decision has expired and there are no allowed clair		se the period for seeking court review
7.   The reason(s) below:		
See Attached		
Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdra minimize any negative effects on patent term.	aw the holding of abandonment under 37	CFR 1.181, should be promptly filed to

	Application No.	Applicant(s)
; Communication Re: Appeal	00/000,000 09694 065	SMITH
• •	Examiner	Art Unit
	S. Thomas Hughes	3714
The MAILING DATE of this communication appear	rs on the cover sheet with the o	correspondence address
1. The Notice of Appeal filed on is not accept	otable because:	
(a) it was not timely filed.		
(b)  the statutory fee for filing the appeal was n	ot submitted. See 37 CFR 1.17(	b).
(c) the appeal fee received on was not	timely filed.	
(d) the submitted fee of \$ is insufficient.	The appeal fee required by 37 C	FR 1.17(b) is \$
(e)  the appeal is not in compliance with 37 CF rejection in this application.	R 1.191 in that there is no record	l of a second or a final
(f) a Notice of Allowability, PTO-37, was mail	ed by the Office on	
2. The appeal brief filed on is NOT acceptal	ble for the reason(s) indicated be	low:
(a)  the brief and/or brief fee is untimely. See	37 CFR 1.192.	
(b)  the statutory fee for filing the brief has not	been submitted. See 37 CFR 1.	17(c).
(c) the submitted brief fee of \$ is insuffi	cient. The brief fee required by 3	7 CFR 1.17(c) is \$
The appeal in this application will be dismissed brief and requisite fee. Extensions of time may		
3. ☑ The appeal in this application is DISMISSED be	cause:	
<ul> <li>(a)  the statutory fee for filing the brief as requiperiod for obtaining an extension of time to</li> </ul>		
(b)  the brief was not timely filed and the period CFR 1.136 has expired.	d for obtaining an extension of tin	ne to file the brief under 37
(c) Request for Continued Examination (RCE	i) under 37 CFR 1.114 was filed o	on
(d) ⊠ other: <u>See attached</u>		
4.   Because of the dismissal of the appeal, this app	lication:	
(a) 🛛 is abandoned because there are no allowed	ed claims.	
<ul><li>(b) is before the examiner for final disposition on the merits remains CLOSED.</li></ul>	because it contains allowed clair	ns. Prosecution
(c) is before the examiner for consideration of to 37 CFR 1.114.	the submission and prosecution	has been reopened pursuant
	S. Tho SPE Art Uni	mas Hughes t: 3714

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## DETAILED ACTION

On 3 February 2003, Applicant submitted an Appeal Brief. This Appeal Brief was defective because of improper grouping of the claims. Applicant was notified of these defects on 19 May 2003. Applicant filed another Appeal Brief on 19 June 2003. Examiner reopened prosecution to correct a typographical error in the Final Rejection (one of the claims had not been listed as rejected) and informed the Applicant that the grouping of the claims was still improper. Examiner warned the Applicant that should Applicant submit another Appeal Brief with improper grouping of the claims, 37 CFR 1.192(d) requires that the appeal will stand abandoned. Applicant was told that this was automatic and that Examiner did not have discretion in the matter.

On 3 December 2003, Applicant submitted another Appeal Brief. Once again, the grouping of the claims is defective.

37 CFR §1.192(c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

The MPEP further states:

Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the "Argument" section of the brief, the appellant should be notified of the noncompliance as per 37 CFR

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1.192(d). Ex parte Schier, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); Ex parte Ohsumi, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).

There are several defects in the grouping of claims. The following is not an exhaustive list:

- 1. In at least three cases, for a single ground of rejection (Claims 33, 40 & 43-49 as being anticipated by LeStrange; Claims 1-10 & 12 as obvious over Jorasch in view of Kishishita; and claims 17-30, 32 and 55-61 as obvious over Jorasch in view of LeStrange), Applicant has failed to state that the claims are separately patentable and do not stand or fall together. Yet Applicant argues some claims as standing and falling together and some as separately patentable.

  Applicant seems to have attempted to get around the requirement of the rules by dividing the claims into two groups. This does not comply with the rule.
- 2. In many of the groups, Applicant states that the claims are separately patentable. Yet in almost every case, Applicant fails to explain why the claims are believed to be separately patentable. Instead, Applicant points out differences in what the claims cover (i.e., additional limitations contained in the claims). As 37 CFR §1.192(c)(7) clearly states, "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." The rule requires Applicant to explain why the additional limitation makes the claim separately patentable. Applicant has consistently failed to make any such explanation.
- 3. In Group VIII, 55 & 56 and 57 & 58. Applicant does not even point out differences between the claims.

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4. In Group IX, Applicant states that claims 38, 39, 41, and 42 are separately patentable, but fails to argue the separate patentability of claims 38 and 39 and 41 and 42. Applicant argues 38 & 39 as one subgroup and 41 & 42 as another subgroup.

5. In Group XIV, Applicant states that claims 52-54 are separately patentable, but fails to argue the separate patentability of claims 53 and 54. Applicant does not even point out differences between the claims.

As noted above, this is not an exhaustive list. Applicant has been repeatedly warned that all problems with the grouping of the claims had to be corrected or the case would be abandoned by operation of law. On at least two occasions, Examiner has referred Applicant to 37 CFR §1.192(d), which states:

If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

Applicant has repeatedly filed an amended brief which does not overcome all the reasons for non-compliance stated in the notification. Thus the appeal stands dismissed. Furthermore, since there are no allowable claims, the Application is abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cbc

S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700